

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 3, 4 and 6-10 will have been amended and claims 13-18 will have been submitted for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 1-6, 8, 9, 11 and 12 under 35 U.S.C. § 112, first paragraph, as failing with comply with the written description requirement. The Examiner notes that "once the service provider has been disconnected, it is understood that another communication is not performed until the connection is re-established. Applicant does not disclose on page 8, paragraphs [0032]-[0036] that another communication is not performed. It is also not understood why a machine designed for communication would not perform another communication". Applicant respectfully traverses the above rejection.

In this regard, Applicant submits that the specification does not disclose that another communication is not performed at all (page 8, paragraphs [0032]-[0036] and Fig. 5). Rather, Applicant submits that a stop button 34 is provided in the present application so that a user can request that the line be disconnected during e-mail reception (page 4, paragraph [0012]), but the stop button is not utilized for performing another communication after disconnecting the line during e-mail reception. Based on the above recited portions of the disclosure, Applicant recites an e-mail receiver that,

“when the stop button is pressed while receiving the e-mail data”, disconnects the connection to the service provider and requires operation of a start button to perform another communication. This recitation is in contrast to the disclosure of the embodiment illustrated in Fig. 5 at steps 5104-5108 where a next message is received. Thus, Applicant submits that the claimed subject matter is properly described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant has amended the recitations of the claims to clarify this aspect of the present invention.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection.

The Examiner has rejected claims 7 and 10 under 35 U.S.C. § 102(e) as being anticipated by SEKIGUCHI (U.S. Patent No. 6,898,627). The Examiner has rejected claims 1-5, 8, 9 and 11-12 under 35 U.S.C. § 103(a) as being unpatentable over FUJUKI (U.S. Patent No. 6,542,254) in view of WANG (U.S. Patent No. 6,757,891). The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over FUJUKI (U.S. Patent No. 6,542,254) in view of WANG (U.S. Patent No. 6,757,891) and SEKIGUCHI (U.S. Patent No. 6,898,627).

As noted above, Applicant has amended, *inter alia*, claim 7 and has submitted claims 13-18 for consideration. Applicant respectfully traverses the above rejections based on pending claims 1-18 and will discuss these rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The

amendments to the claims and the submitted claim merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Regarding the rejection of claims 7 and 10 under 35 U.S.C. § 102(e), Applicant's claim 7 generally relates to a dial-up Internet facsimile apparatus that includes a modem that a makes dial-up connection to a service provider of e-mail via a telephone line. The dial-up Internet facsimile apparatus further includes an e-mail receiver that receives data regarding a size of e-mail from the service provider before receiving the e-mail, skips reception of the e-mail with the received size when the received size data of the e-mail exceeds a predetermined value, and proceeds to reception of a next e-mail without receiving either the header of the e-mail with the received size. Claim 10 recites a related method.

In direct contrast, SEKIGUCHI relates to an e-mail/facsimile machine 1-11 which obtains e-mail data from an e-mail server 1-10, converts the e-mail data into image data, sends the converted image data to a facsimile machine 1-13. After the e-mail/facsimile machine 1-11 receives the e-mail data 1 from the e-mail server 1-10 (Fig. 3, step 2-7), the e-mail/facsimile machine 1-11 transmits to the e-mail server 1-10 a request for deleting the e-mail data 1. Then, once the e-mail data is successfully decoded, the e-mail server 1-10 deletes the e-mail data 1, as shown at step 2-8 of Fig. 3 (column 10, lines 16-21).

However, SEKIGUCHI does not disclose a dial-up Internet facsimile apparatus which receives data regarding a size of e-mail from the service provider before receiving the e-mail, skips reception of the e-mail with the received size when the received size data of the e-mail exceed a predetermined value, and proceeds to

reception of a next e-mail without receiving the e-mail with the received size. Rather, in SEKIGUCHI, the e-mail/facsimile machine 1-11 receives the e-mail data 1 from the e-mail server 1-10 (Fig. 3, step 2-7). Then, the e-mail/facsimile machine 1-11 transmits to the e-mail server 1-10 a request for deleting the e-mail data (Fig. 3, step 2-8). However, such deleting occurs once the e-mail data has been received and successfully decoded. In direct contrast, the present invention, as defined in claim 7, "skips reception" when the size data of the e-mail data exceeds a predetermined value.

On the other hand, the present invention recites a dial-up Internet facsimile apparatus which receives data regarding a size of e-mail from the service provider before receiving the e-mail, skips reception of the e-mail with the received size when the received size data of the e-mail exceeds a predetermined value, and proceeds to reception of a next e-mail without receiving the e-mail with the received size. After skipping to the reception of the next e-mail, the a dial-up Internet facsimile apparatus can receive the next e-mail data without receiving the skipped e-mail, when the size data of the next e-mail does not exceed the predetermined value.

In setting forth the rejection, the Examiner notes that SEKIGUCHI eliminates e-mail over a predetermined size from e-mails to be received. This is incorrect. While SEKIGUCHI does disclose receiving data regarding a size of an e-mail, that size information is not used in the manner suggested by the Examiner. The size information is utilized as set forth in the paragraph beginning on column 10, line 66. In this regard, in SEKIGUCHI, when it is determined that the memory is insufficient to receive all e-mail data because the amount of e-mail data is greater than the currently available memory space, the CPU receives only the header of the e-mail. Thus,

contrary to the Examiner's assertion, even when the data is greater than the capacity of the memory, the header of the e-mail is still received. In particular and again contrary to the Examiner's interpretation of SEKIGUCHI, the e-mail data under such circumstances is not deleted. In this regard, the Examiner's attention is respectfully directed to column 11, line 17.

In this regard, the Examiner asserts in the outstanding Official Action mailed on April 28, 2006, that a data delete request associated with the e-mail data 1 is sent to the e-mail server 1-10 in step 2-8 to delete e-mail messages from the e-mail server 1-10 (column 10, lines 16-21). However, according to the cited portion of SEKIGUCHI, when the body of the email data has been successfully decoded into the form of facsimile image data and thus CPU 10-3 determines that there is no data which cannot be interpreted or cannot be decoded, a data delete request associated with the e-mail data 1 is sent to the e-mail server 1-10 in step 2-8 to delete e-mail messages from the e-mail server 1-10. In other words, in accordance with the teachings of SEKIGUCHI, e-mail data is deleted only when it has been received, processed, and is no longer necessary. Thus, when e-mail data is successfully decoded, the original e-mail data is deleted whereas if for some reason the e-mail data cannot either be totally received or cannot be processed (i.e., decoded), then it is not deleted because it is still necessary for the operation of the device. Accordingly, the disclosure of SEKIGUCHI does not contain the combination of features recited in Applicant's claims which require, inter alia, not deletion of e-mail, but skipping to the reception of the next e-mail when the data size of an e-mail is greater than a predetermined amount.

Further, the Examiner notes in the outstanding Official Action mailed on April 28, 2006 that the apparatus can filter wanted/unwanted emails based on the information data retrieved from the server 1-10. However, Applicant submits that the present invention does not relate to the apparatus that can filter wanted/unwanted emails based on information data retrieved from a server. Rather, in order to avoid unnecessary telephone charges, the present invention recites a dial-up Internet facsimile apparatus which receives data regarding a size of e-mail from the service provider before receiving the e-mail, skips reception of the e-mail with the received size when the received size data of the e-mail exceeds a predetermined value, and proceeds to reception of a next e-mail without receiving the e-mail with the received size. Further, after skipping to the reception of the next e-mail, the a dial-up Internet facsimile apparatus can receive the next e-mail without receiving the skipped e-mail, when the size data of the next e-mail does not exceed the predetermined value.

Thus, claims 7 and 10 are clearly distinguished over SEKIGUCHI.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 7 and 10 are not disclosed in or suggested by SEKIGUCHI cited by the Examiner. Applicant notes that absent a disclosure in a single reference of each and every element cited in a claim, a prima facie case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 7 and 10, these claims are not anticipated thereby. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. § 102. An indication of the allowability of claims 7 and 10 is thus respectfully requested.

Regarding the rejection of claims 1-5, 8 and 9 under 35 U.S.C. § 103(a), Applicant's claims 1-3 generally relate to a dial-up Internet facsimile apparatus that includes a modem that makes dial-up connection to a service provider of e-mail via a telephone line and an operation section that includes at least a start button and a stop button. The stop button is configured for disconnecting the connection to the service provider. The dial-up Internet facsimile apparatus comprises an e-mail receiver that receives e-mail data from the connected service provider and that, when the stop button is operated while receiving the e-mail data, disconnects the connection to the service provider without waiting for the completion of the e-mail data reception and requiring operation of the start button to perform another communication. Claim 8 recites a related method.

Applicant's claims 4-6 generally relate to a dial-up Internet facsimile apparatus that includes a modem that makes a dial-up connection to a service provider of e-mail via a telephone line and an operation section that includes a stop button. The stop button is configured for interrupting the reception of the e-mail data from the service provider. The dial-up Internet facsimile apparatus further includes an e-mail receiver that receives e-mail from the connected service provider and that, when the stop button is operated while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception. The e-mail receiver proceeds to the reception of the next e-mail data from the service provider after the interruption in the reception of e-mail data without an intervening data reception communication. Claim 9 recites a related method.

In direct contrast to the above, FUJIKI relates to a facsimile device in which, when a facsimile communication request is made (Fig. 2, S5) while a line connection to the Internet service provider is already established (Fig. 2, S4), halts electronic mail reception (Fig. 2, S7) and performs facsimile communication (Fig. 2, S9).

However, FUJIKI does not disclose a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for disconnecting the connection to the service provider and requiring operation of a start button to perform another communication. FUJIKI also does not disclose a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for interrupting the reception of the e-mail data from the service provider without performing a facsimile communication. Rather, FUJIKI merely discloses the keypad 5 for substituting facsimile transmission instead of the e-mail transmission (column 4, lines 11-18 and column 5, lines 10-14). In other words, in FUJIKI, the operation of halting the electronic mail reception inevitably includes performing the facsimile transmission thereafter.

Further, FUJIKI does not disclose a dial-up Internet facsimile apparatus which, when the stop button is pressed while receiving the e-mail data, disconnects the connection to the service provider without waiting for the completion of the e-mail data reception, and requires operation of a start button to perform another communication. Rather, FUJIKI merely performs the facsimile communication automatically (Fig. 2, S9) after the halt of the electronic mail reception (Fig. 2, S7), when the facsimile transmission is requested (Fig. 2, S5) before the halt of the electronic mail reception



(Fig. 2, S7). In other words, in FUJIKI, the operation of halting the electronic mail reception inevitably includes performing the facsimile transmission thereafter.

Additionally, not only does FUJIKI, immediately upon halting the e-mail reception, start a facsimile communication, but upon the conclusion of the facsimile communication, a dial-up connection is automatically made to the Internet service provider as evidenced by the flow after step S9, which leads back to step S3. Thus, while the disconnection of the connection to the service provider according to the features of the present invention requires operation of a start button to perform another communication, according to the teachings of FUJIKI both a facsimile operation and a further electronic mail communication are inevitably performed after disconnection.

On the other hand, the present invention recites a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for disconnecting the connection to the service provider. The present invention also recites an e-mail reception section that receives e-mail data from the connected service provider and that, when the stop button is pressed while receiving the e-mail data, disconnects the connection to the service provider without waiting for the completion of the e-mail data reception, and requires operation of a start button to perform another communication.

Additionally, Applicant notes that based on the flowchart of Fig. 2 of FUJIKI, the determination (checking for a facsimile communication requests) in step S5 occurs "upon receiving one page of image data equivalent electronic mail message" (column 5, lines 23-25). This means that FUJIKI does not disconnect the connection to the service provider without waiting for the completion of the e-mail data reception. Rather,

FUJIKI disconnects the connection to the service provider after the completion of the e-mail data reception. Thus, FUJIKI does not teach disconnecting the connection to the service provider in the middle of receiving one page of image data equivalent electronic mail message.

Thus, pending claims 1-3 and 8 are clearly distinguished over FUJIKI.

Regarding independent claim 4, FUJIKI does not disclose a dial-up Internet facsimile apparatus which, when the stop button is pressed while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception, the receiver proceeding to the reception of the next e-mail data from the service provider after the interruption in the reception of the e-mail data without an intervening data reception communication. Rather, FUJIKI performs the facsimile communication (Fig. 2, S9) when the facsimile transmission is requested (Fig. 2, S5), after the electronic mail reception is halted (Fig. 2, S7). In other words, FUJIKI performs a type of communication (the facsimile communication) that is different from the e-mail communication after the electronic mail reception is halted. Thus, FUJIKI does not proceed to the reception of the next e-mail data "from the service provider" after the interrupted e-mail data. In other words, FUJIKI, after interrupting the e-mail reception, performs a facsimile communication, and thereafter merely dials-up and reconnects to the Internet service provider. However, FUJIKI does not receive "the next e-mail data" after interrupting the e-mail reception without an intervening data reception of communication.

On the other hand, the present invention recites a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for

interrupting the reception of the e-mail data from the service provider. The present invention includes an e-mail receiver that receives e-mail from the connected service provider and that, when the stop button is pressed while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception, said receiver proceeding to the reception of the next e-mail data from the service provider after the interrupted e-mail data without an intervening data reception communication.

Additionally, Applicant notes that based on the flowchart of Fig. 2 of FUJIKI, the determination in step S5 occurs "upon receiving one page of image data equivalent electronic mail message" (column 5, lines 23-25). This means that FUJIKI does not disconnect the connection to the service provider without waiting for the completion of the e-mail data reception. Rather, FUJIKI disconnects the connection to the service provider after the completion of the reception of a full page of e-mail data. Thus, at least, FUJIKI cannot disconnect the connection to the service provider in the middle of receiving one page of image data equivalent electronic mail message.

Thus, pending claims 4-5 and 9 are clearly distinguished over FUJIKI.

Therefore, it is respectfully submitted that the features recited in Applicant's claims 1-5, 8 and 9 are not disclosed in or suggested by FUJIKI cited by the Examiner.

In setting forth the rejection, the Examiner relies on WANG to overcome the deficiencies of FUJIKI. According to the Examiner, WANG teaches the button 56 which is used to interrupt the e-mail communication when the user needs to use the telephone (column 6, lines 47-48).

However, WANG does not disclose a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for disconnecting the connection to the service provider. WANG also does not disclose a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for interrupting the reception of the e-mail data from the service provider. Rather, WANG merely discloses the button 56 which is part of an answering machine and is used to interrupt the e-mail communication when the user needs to use the telephone (column 6, lines 47-48). There is thus no proper motivation for combining features from these references.

Further, WANG does not disclose a dial-up Internet facsimile apparatus which, when the stop button is pressed while receiving the e-mail data, disconnects the connection to the service provider without waiting for the completion of the e-mail data reception, and requires operation of a start button to perform another communication (claim 1). Rather, WANG suggests performing a telephone communication after the interruption of the e-mail communication (column 6, lines 47-48). In other words, WANG merely contains a disclosure similar to that of FUJIKI. Thus, in WANG, the operation of interrupting the e-mail communication is related to a subsequent telephone communication.

On the other hand, the present invention recites a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for disconnecting the connection to the service provider. The present invention also recites an e-mail receiver that receives e-mail data from the connected service provider and that, when the stop button is pressed while receiving the e-mail data, disconnects

the connection to the service provider without waiting for the completion of the e-mail data reception, and requires operation of a start button to perform another communication (claim 1).

In this regard, the Examiner asserts in the outstanding Official Action mailed on April 28, 2006 that WANG discloses an interrupt button 56 that is used to interrupt E-mail communication (column 6, lines 47-48). However, the interrupt button 56 is used to interrupt E-mail communication and to perform a telephone communication. In other words, the operation of halting the electronic mail reception inevitably includes performing the telephone communication thereafter. Thus, WANG does not disclose a stop button that is utilized for disconnecting the connection to the service provider and requiring an additional button actuation to perform another communication, as recited in the pending claims.

WANG also does not disclose a dial-up Internet facsimile apparatus which, when the stop button is pressed while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception, the receiver proceeding to the reception of the next e-mail data from the service provider after the interruption in reception of the e-mail without an intervening data reception communication. Rather, WANG performs a telephone communication after the interruption of the e-mail communication (column 6, lines 47-48). In other words, WANG performs a type of communication (a telephone communication) different from the e-mail communication after the interruption of the e-mail communication. Thus, WANG does not proceed to the reception of the next e-mail data "from the

service provider” after the interruption in reception of the e-mail without an intervening data reception communication (claim 4).

On the other hand, the present invention recites a dial-up Internet facsimile apparatus which includes a stop button, the stop button being configured for interrupting the reception of the e-mail data from the service provider. The present invention recites an e-mail receiver that receives e-mail from the connected service provider and that, when the stop button is pressed while receiving the e-mail data, interrupts the reception of the e-mail data from the service provider without waiting for the completion of the e-mail data reception, said receiver proceeding to the reception of the next e-mail data from the service provider after the interruption in the reception of the e-mail data without an intervening data reception communication.

Moreover, there is no indication whatsoever within WANG that the interruption by button 56 of e-mail communication occurs in the middle of an e-mail reception. Rather, it can merely interrupt an e-mail communication at the end of the next reception of data.

Thus, the pending claims are clearly distinguished over WANG.

Therefore, it is respectfully submitted that features recited in Applicant's claims 1-5, 8 and 9 are not disclosed in or suggested by FUJIKI or WANG cited by the Examiner. In both FUJIKI and WANG, interruption of one type of communication results in initiation of another type of communication which is contrary to the recitations of the pending claims. Thus, the pending claims are also submitted to be patentable over the Examiner's proposed combination, since even the combination of FUJIKI and

WANG does not disclose the combination of the features recited in Applicant's claims 1-5, 8 and 9.

Moreover, the Examiner has not set forth a proper motivation for the proposed combination. FUJIKI relates to a facsimile device in which the checking for a facsimile communication request occurs "upon receiving one page of image data equivalent electronic mail message" (column 5, lines 23-25 and S5 of Fig. 2). Further, FUJIKI relates to a facsimile device which performs the facsimile communication after the halt of the electronic mail reception, based on the request of the facsimile transmission before the halt of the electronic mail reception. Thus, FUJIKI neither suggests interrupting the connection to the service provider without waiting for the completion of the e-mail data reception and requiring operation of a start button to perform another communication nor suggests interrupting the connection to the service provider without waiting for the completion of the e-mail data reception and proceeding to the reception of the next e-mail data from the service provider after interruption of the reception of the e-mail data without an intervening data reception communication.

On the other hand, WANG merely suggests interrupting an e-mail communication at the end of the next reception of data and performing a telephone communication after the interruption of the e-mail communication. Thus, WANG also neither suggests interrupting the connection to the service provider without waiting for the completion of the e-mail data reception and requiring operation of a start button to perform another communication nor suggests interrupting the connection to the service provider without waiting for the completion of the e-mail data reception and proceeding to the reception of the next e-mail data from the service provider after the interruption in

reception of the e-mail data without an intervening data reception communication. Moreover, WANG is directed to adapting an existing telephone system to receive and deliver electronic messages. WANG is not directed to a dial-up Internet facsimile apparatus as recited in the claims of the present application. Accordingly, although both the WANG and FUJIKI documents relate to a generally similar area of technology, the functional and structural differences between them are so significant that one of ordinary skill in the art would not be motivated to modify the FUJIKI disclosure in view of the WANG disclosure.

Regarding the rejection of claim 6 under 35 U.S.C. § 103(a) based on FUJIKI in view of WANG and SEKIGUCHI, Applicant submits that claim 6 is dependent from allowable independent claim 1, which is allowable for at least the reasons discussed supra. Thus, dependent claim 6 is also allowable for at least the reasons discussed supra. Further, dependent claim 6 sets forth a further combination of elements neither taught nor disclosed by any of the applied references.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application in due course.

Although the status of the application is after final rejection, Applicant submits that entry of the amendment is proper under 37 C.F.R. § 1.116. In particular, no new issues or questions of new matter are being presented. It is assumed that the Examiner has searched and considered the claim limitations as they were discussed in the specification.



SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner and has submitted additional claims for consideration.

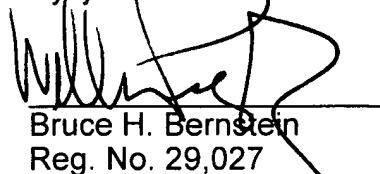
With respect to the pending claims, Applicant has pointed out the features thereof and has contrasted the features of the pending claims with the disclosures of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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